

## REMARKS

In accordance with the foregoing, claims 5-7 have been amended. No claims have been cancelled. Claims 8-9 are hereby added. Claims 1-9 are now pending in the case. No new matter is being presented. Reconsideration is respectfully requested.

## REJECTIONS UNDER 35 U.S.C. §112

At page 2 of the Office Action, claims 5-7 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as their invention. Specifically, the Examiner states that claim 5 recites the structure of an apparatus and steps of a process for using the apparatus. Claims 5-7 have been amended and are now believed to be in condition for allowance.

## REJECTIONS UNDER 35 U.S.C. §101

At page 2 of the Office Action, claims 5-7 are rejected under 35 U.S.C. §101 as embracing or overlapping two different statutory classes of invention. The Examiner states that claim 5 recites the structure of an apparatus and steps of a process for using the apparatus. Claims 5-7 have been amended and are now believed to be in condition for allowance.

## REJECTIONS UNDER 35 U.S.C. §102

At pages 2-3 of the Office Action, claims 1 and 3-7 are rejected under 35 U.S.C. §102(e) "as being anticipated by Chelvayohan." The Applicants respectfully traverse this rejection.

As an initial matter, the Applicants respectfully submit that the Examiner has failed to meet his burden under 37 CFR 1.104(d)(1) with respect to this rejection. Domestic patents and patent applications must be cited by number, date and patentee name. 37 CFR 1.104(d)(1). The rejection does not cite a specific reference. Rather, the rejection simply cites "Chelvayohan." The Notice of References Cited lists three different references that name Chelvayohan (U.S. Patent Nos. 6,590,223; 6,794,669; and U.S. Patent Application Publication No. 2004/0017416). Although the Applicants have made the assumption that the present 102(e) rejection is based upon U.S. Patent No. 6,590,223 for purposes of this Response, the Applicants respectfully request that the next Office Action be made non-final if this particular rejection is repeated, as the Applicants have not had an opportunity to properly address the rejection.

Regarding claims 1 and 5, Chelvayohan is cited for teaching the pick-up switch unit of the present invention. The Applicants respectfully disagree. Claim 1 requires "a pick-up switch unit to output a paper entrance determination signal by comparing an output signal from the light

receiving unit with a predetermined reference signal." Claim 5 requires unit that produces "a paper entrance determination signal... output from a pick-up switching part, determining that paper is provided and turning off the light emitting unit." That is, the present invention has a pick-up switch unit that outputs a paper entrance determination signal by comparing an output signal to a reference signal, OR produces a paper entrance determination signal and light turn-off. Claim 1 also calls for a controller while claim 5 also calls for detecting type if the paper is aligned.

The media type detector of Chelvayohan comprises a housing 160 and a recess 170. When a piece of paper 105 is present in the media type detector, the housing 160 and the recess 170 are separate from one another to accommodate the piece of paper 105. *Chelvayohan, FIG. 2.* After the piece of paper is removed, the housing 160 and the recess 170 are brought together to accomplish the objective of the Chelvayohan invention, namely, blocking light. The paper 105 enters the space between the housing 160 and recess 170 before the paper 105 reaches the light from sensor 110.

The Applicants respectfully submit that since Chelvayohan fails to teach or suggest all of the elements of claims 1 and 5, claims 1 and 5 are allowable over Chelvayohan. Thus, withdrawal of the 102(e) rejection is respectfully requested.

Regarding the rejection of claims 3-4 and 6-7, these claims depend directly or indirectly on one of independent claims 1 or 5 and are therefore believed to be allowable for at least the reasons noted above.

#### **REJECTION UNDER 35 U.S.C. §103**

At page 3 of the Office Action, claim 2 is rejected under 35 U.S.C. §103(a) as being unpatentable over "Chelvayohan" in view of U.S. Patent No. 4,578,770 to Mitani. The Applicants respectfully traverse this rejection.

As an initial matter, the Applicants respectfully submit that, as discussed above, the Examiner has failed to meet his burden under 37 CFR 1.104(d)(1) with respect to this rejection. The rejection does not cite a specific primary reference with respect to obviousness. Rather, the rejection simply cites "Chelvayohan." Although the Applicants have made the assumption that the present 103(a) rejection is based upon U.S. Patent No. 6,590,223 for purposes of this Response, the Applicants respectfully request that the next Office Action be made non-final if this particular rejection is repeated, as the Applicants have not had an opportunity to properly address the rejection.

Claim 2 depends from claim 1. The Examiner states that Chelvayohan "teaches everything except employing a circuit to process the signal from the media sensor including an A/D converter." As discussed above, Chelvayohan does not teach the pickup switch unit of the present invention. The Applicants respectfully submit that Mitani fails to make up for this deficiency. Rather, Mitani is directed to a method of discriminating defects in bank notes.

The Applicants respectfully submit that at least because neither Chelvayohan nor Mitani, individually or combined, teach or suggest all of the elements of claim 2, the combination of Chelvayohan and Mitani fails to establish a prima facie case of obviousness. Accordingly, claim 2 is deemed allowable over the art of record. Therefore, withdrawal of the §103(a) rejection is respectfully requested.

### **NEW CLAIMS 8 AND 9**

New claim 8 is directed to an apparatus to feed paper including a media sensor comprising "at least one light receiving unit to receive light reflected off of a piece of paper" and "a controller to determine whether the piece of paper is provided on a basis of a first signal from the at least one light receiving unit, and to determine a paper type using a second signal from the at least one light receiving unit." Therefore, it is submitted that claim 8 patentably distinguishes over the prior art.

New claim 9 depends from claim 8 and further recites an "analog/digital converter to convert at least one of the first or second signals." Therefore, it is submitted that claim 9 patentably distinguishes over the prior art.

### **CONCLUSION**

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

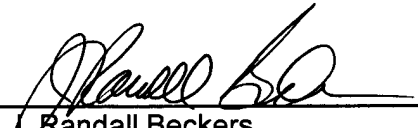
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If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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